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09/927,016	08/09/2001	V. Christopher Brown	5063A	4151

7590

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Milliken & Company  
P.O. Box 1927  
Spartanburg, SC 29304

EXAMINER

RHEE, JANE J

ART UNIT

PAPER NUMBER

1772

5

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-5

## Office Action Summary

Application No.

09/927,016

Applicant(s)

BROWN ET AL.

Examiner

Jane J Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-17, drawn to an article, classified in class 428, subclass 47.
  - II. Claims 18-19, drawn to an article, classified in class 428, subclass 96.
  - III. Claims 20-21, drawn to a method, classified in class 264.
2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have a different amount of piles where the floor mat in claim 1 has three piles consisting of pile backing, pile material, and rubber backing and claim 18 consist of a pile surface that is jet dyed. Claim 18 does not claim the three piles that are in claim 1 and claim one does not have a surface that is jet dyed.
3. Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process such as cutting the rubber backing sheet, placing the carpet substrates on top of the backing sheet and individually vulcanize the carpet substrates and backing sheet together.

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4. Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process wherein the product is jet dyed and the dyed yarn is tufted with a graphics tufting machine.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Alexander on August 6, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-21 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 11 recites the limitation "carpet pile" in line 1. There is insufficient antecedent basis for this limitation in the claim.
6. The term "may have" in claim 14 is a relative term which renders the claim indefinite. The term "may have" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1,4-13, 15, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimono et al. (5887416).

Shimono et al. discloses a floor mat system comprising floor mats having the same width (col. 4 line 40) and each floor mat comprising a carpet pile backing or carrier (col. 2 line 56), a pile material tufted into the carpet pile backing which forms a

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pile surface on one side of the pile backing (col. 2 lines 55-56), and a vulcanized rubber backing sheet integrated to the other side of the pile backing (col. 2 line 60 and col. 4 lines 40-44). Shimono et al. discloses that the floor mat possesses suitable flexibility to be laundered on a regular basis in a standard industrial washing machine without appreciably damaging the mat or the machine (col. 4 lines 45-47). Shimono et al. discloses that the carpet pile backing is nonwoven polyester (col. 4 lines 13-14). Shimono et al. discloses that the mats have a width of about 28 inches (col. 4 line 40). Shimono et al. discloses that the carpet backing is comprised of natural or synthetic fibers or blends thereof (col. 4 line 13-14). Shimono et al. discloses that the carpet pile weighs from 3.5 to 4.5 and less than 20 ounces per square yard (col. 4 lines 13-14). Shimono et al. fail to disclose a plurality of floor mat sizes such as 28"X42", 28"X59", 49"X57", and 28"X100", a number of colors, a total mat weight of 0.60 lbs/sq.ft. and a 60 mil thickness of rubber. Shimono et al. also fail to disclose 100% jet dyed nylon fibers.

As to the claimed plurality of floor mat sizes, Shimono et al. teaches the specific size of the floor mat (col. 4 line 40) depending on the end use of the size of the product. Therefore, the claimed different plurality of floor mat would be readily determined through routine experimentation depending on the end use of the product and would be obvious in view of Shimono et al. Furthermore, it has been held that the modification of the size would have involved a mere change in the size. Therefore, a change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose 105 USPQ 237 (CCPA 1955).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the floor mat with a different size as shown by Shimono et al.

As to the number of colors that the floor mat is offered, Shimono et al. discloses that the nylon yarn has a large variety of color as compared with the conventional outdoor mat (col. 3 line 30), it would have been an obvious matter of design choice to have multiple different colors offered to a floor mat. Furthermore, color within itself is not patentable.

As to the total weight of the mat, Shimono et al. discloses that the pile material weights  $1.32\text{kg/m}^2$  (col. 4 line 10) and that the carpet pile backing layer weights  $.15\text{kg/m}^2$  (col. 4 line 14). The weight of the rubber backing and the bonding agent is not disclosed, however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have obtained a total mat weight of 0.60 lbs/sq.ft. since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

As to the thickness of the rubber, Shimono et al. discloses 2 mm thick rubber sheet (col. 4 lines 40-41) which is 78.7 mils, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have obtained 60 mils thick of rubber since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

As to the claimed jet dyed nylon fiber, applicant is claiming a process limitation in the article claim hence, process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation 100% jet dyed is a method of production and therefore does not determine the patentability of the product itself.

8. Claims 1-5, 7-8, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerr. (5902662).

Kerr discloses a floor mat system comprising floor mats each floor mat comprising a carpet pile backing or carrier (col. 3 line 45), a pile material tufted into the carpet pile backing which forms a pile surface on one side of the pile backing (col. 3



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lines 43-45), and a vulcanized rubber backing sheet integrated to the other side of the pile backing (col. 3 lines 46-47 and col. 4 lines 25-26). Kerr discloses that the rubber backing sheet comprises a blowing agent to produce a closed cell structure foam rubber (col. 4 lines 65-67, col. 1 lines 38-42). Kerr discloses that the floor mat system comprises solid vulcanized rubber reinforcement strips along at least one of the borders of each mat (col. 3 lines 54-55). Kerr discloses that the floor mat possesses suitable flexibility to be laundered on a regular basis in a standard industrial washing machine without appreciably damaging the mat or the machine (col. 1 lines 43-46). Kerr discloses that the pile material and/or the carpet pile backing is comprised of natural or synthetic fibers or blends thereof (col. 3 lines 44-46). Kerr discloses that the floor mats is one of a plurality of floor mats formed simultaneously from a single backing sheet (col. 3 lines 60-62). Kerr fail to disclose a plurality of floor mat sizes each having the same width. Kerr fail to disclose that the floor mats may have one or three border colors.

It would have been an obvious matter of design choice to have a plurality of floor mat sizes each having the same width, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to the border colors that the floor mat is offered, it would have been an obvious matter of design choice to have multiple different colors offered to border of the floor mat. Furthermore, color within itself is not patentable.

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**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jane Rhee  
October 1, 2002

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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10/1/02